

## **REMARKS**

Claims 1-43 are pending in this application. Claims 7-16 and 27-42 have been withdrawn, and Claim 43 has been canceled. No claims have been added. Claims 1 and 17 have been amended. Reconsideration and allowance of all remaining claims are respectfully requested.

### **After-Final Telephone Interview With Examiner On July 15, 2005**

Examiner Sarah L. Kuhns stated that Applicants' proposed after-final amendments – removing the word “natural” from “natural oil content” in the claims and canceling Claim 43 – were not sufficient to overcome the obviousness rejections. At that time, Examiner still believed it would have been obvious to combine the low-oil content corn products of Ellis with the corn chip crumbs of the cited cooking recipes. Examiner Kuhns recommended that we continue to look for ways to support our position that it would not have been obvious to combine Ellis with the “Salmon Patties” recipe, and further invited us to contact her again upon her return from vacation on Friday, July 22, 2005.

In accordance with Examiner's advice, Applicants have made several amendments to the Claims as shown above and present below several arguments illustrating why it would not have been obvious to combine Ellis with the “Salmon Patties” recipe.

### **Claim Rejections - 35 USC §112**

Examiner states on page 2 in this Office Action as follows:

Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, does not provide support for the newly added limitation, namely, the exclusion of added oil, seasoning, or preservatives.

Applicants respectfully traverse this rejection. Claim 43, however, has been canceled, rendering such rejection moot. Applicants therefore request that the rejection under Section 112 be withdrawn.

### **Claim Rejections and Examiner's Response - 35 USC §102**

Claims 26 and 43 were rejected under 35 U.S.C. §102(b) as being anticipated by "Salmon Patties" for the reasons set forth in the previous office action. In response to Applicants' previously-presented arguments, Examiner also stated in the current Office Action:

Applicant argues that claims 26 and 43 are not anticipated by "Salmon Patties" because "a natural oil content ranging from about 2.0% to 5.0% by weight is required. However, the Examiner submits that this property is inherent, as the same natural source of oil, i.e. the corn, is used in both the additive of the prior art and that claimed by Applicant. The claim language does not exclude the addition of more oil in claim 26. In claim 43, the claim language does recite the exclusion of additional oil, as well as seasoning and preservatives.

Applicant argues that the corn chips of "Salmon Patties" are fried and extruded with an oil content of approximately 30%. However, as stated above, it is inherent that the natural oil content of the chips falls within the claimed range. Also, the claim language does not exclude fried and extruded chips. Additionally, Ellis discloses corn chips wherein the oil content is 2-30% by weight (column 2, lines 34-39). Therefore, Ellis does not teach away from the claimed invention, and it would have been obvious to use the corn chips of Ellis in the manner suggested by "Salmon Patties" because it would have been expected that any corn chips would suffice.

Applicants respectfully traverse the rejection of Claim 26, and the rejection of Claim 43 has been rendered moot by the cancellation of Claim 43. Applicants hereby incorporate their previously-presented arguments regarding the rejections under Section 102, which arguments appear in Applicants' April 26, 2005 Response to Office Action of January 26, 2005. As previously stated, such rejection under §102 for anticipation requires that the single reference teach each and every element or step of the rejected claim. *See Atlas Powder v. E.I. DuPont*, 750 F.2d 1569 (224 USPQ 409) (Fed. Cir. 1984); *See also* MPEP § 2131.01 ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently

described, in a single prior art reference”). Examiner’s rejections under §102 fail to meet this test.

The “Salmon Patties” reference does not disclose a toasted corn flavor material, as claimed in amended Claim 17, which is derived from dent corn and has a moisture content ranging from about 0.5% by weight to about 15% by weight. Nor does the “Salmon Patties” reference disclose the limitation of an oil content ranging from about 2.0% to about 5.0% by weight. Thus, the “Salmon Patties” reference fails to disclose each and every element of Claim 26, which depends from and incorporates all such limitations of amended Claim 17. Applicants therefore request that the rejections under Section 102 be withdrawn.

#### **Claim Rejections and Examiner’s Response - 35 USC §103**

Examiner states on page 3 in this Office Action as follows:

Claims 1, 4, 5, and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over “Salmon Patties” in view of Ellis for the reasons set forth in the previous office action.

Claims 2 and 3 are rejected under 35 U.S.C. §103(a) as being unpatentable over “Salmon Patties” in view of Ellis in further view of “A Dinner Experiment” and “Dried Food Products” for the reasons set forth in the previous office action.

Claims 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Food Products Design” in view of “Salmon Patties” and Ellis for the reasons set forth in the previous office action.

Examiner further states on page 4 of this Office Action:

In response to Applicant’s arguments, concerning claims 2 and 3, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 275 (Fed. Cir.1986). “Salmon Patties” has been discussed above. “A Dinner Experiment” was relied on to demonstrate that it was known to chop corn chips until fine in a food processor and “Dried Food Products” was relied on to demonstrate that the particle size claimed by Applicant was a common size for food additives. Therefore it would have been obvious to grind corn chips until the claimed size was reached since such a size was established in the art as being appropriate for food additives.

In regard to Applicant's arguments concerning claim 4, the examples provided do not establish that the specified chips of the prior art do not have the claimed properties.

Applicant argues that it would not have been obvious to combine and/modify the teachings of "Food Product Design," "Salmon Patties," and Ellis to arrive at Applicant's claimed method for making a toasted corn flavor additive. However, as stated above, there is no requirement in the claim language excluding the use of additional oil; the claim only requires that the natural oil content be 2.0-5.0%, which is an inherent property in the food additives of the prior art.

This rejection is respectfully traversed. Applicants hereby incorporate their previously-presented arguments regarding the rejections under Section 103, which arguments appear in Applicants' April 26, 2005 Response to Office Action of January 26, 2005. Additional arguments are also presented below. As previously explained, none of the cited references, alone or in combination, discloses or suggests the invention claimed. Section 706.02(j) of the MPEP states that "[t]o establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, there is no suggestion or incentive to combine the references. As stated in Section 706.02(j) of the MPEP, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

As is known to those of ordinary skill in the art, most corn-derived consumer products are made using dent corn, not waxy corn. Whereas Ellis relates to snack foods made from waxy corn (see Ellis et al. in col. 1, lines 5-11), Applicants' invention – as defined in amended Claim 1, amended Claim 17, dependent Claims 2-6 (which depend from and incorporate all limitations of Claim 1), and dependent Claims 18-26 (which depend from and incorporate all limitations of Claim 17) – originates from dent corn. Similarly, none of the cited recipes disclose or suggest

substituting waxy corn as the starting material, which waxy corn is specifically required in Ellis. Waxy corn is typically used for livestock feed or for making thickeners and stabilizers and is not used or processed for human consumption. As is taught in column 1, lines 24-28 of Ellis, “The varying amounts of amylopectin and amylose in the starch compositions of dent and waxy corns produce substantially different characteristics.” Ellis then continues in the next sentence, “Thus, dent and waxy corns are not considered to be interchangeable materials for most applications.” In fact, various other prior art references teach away from the use of waxy corn as a raw material for consumer products. For example, as noted by Ellis in column 1, lines 59-62, “Murray et al. (U.S. Pat. No. 3,407,070) teach away from the use of a predominant amount of starch derived from waxy corn as a raw material for read(y)-to-eat food products.” Section 2143.01 of the MPEP mandates that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency).” Thus, one of ordinary skill in the art would not be motivated to make the changes proposed by the Examiner, as prior art references such as Murray et al. teach away from the Ellis et al.’s use of waxy corn to produce products intended for human consumption.

Furthermore, Ellis does not address, nor does it even mention, Applicants’ particular problem or solution for creating a concentrated toasted-flavor additive for enhancing the toasted flavor and toasted appearance of food products. Although the Ellis reference discloses a baked corn product, Ellis is directed to an entirely different problem of producing low-oil content corn products having a tender texture and derived from waxy corn. In fact, Ellis teaches away from Applicants’ low-oil-content flavor additive made from traditional dent corn. Note how Ellis

teaches that dent corn should not be used for low-oil content product: in column 3, lines 64-68, Ellis states that “Waxy corn masa, unlike dent corn masa, is also amenable to baking to yield a very tender low oil snack food product [that] is contrasted to dent corn masa which becomes hard and unpalatable at such low oil levels.” Furthermore, Ellis clearly admits in column 4, lines 58-60 that “white waxy corn masa produces a cooked food product that is tender, but not having a colorful appeal to the consumer.” Ellis similarly states in column 7, lines 18-22 that “tortilla chips made from white waxy corn were determined to be significantly lighter in color . . . and blander flavor than corresponding tortilla chips derived from dent corn masa.” In describing one example of forming a baked, low-oil product using waxy corn, Ellis firmly states in column 7, lines 66-69, “Dent corn masa cannot be similarly processed and retain palatable characteristics.” Thus, it would not have been obvious to one skilled in the art to combine the high-oil-content fried corn chip grind of Salmon Patties with Ellis et al.’s low-oil-content, bland, lighter-colored, baked, waxy-corn-derived product to produce Applicants’ dent-corn-derived, low-oil-content, toasted flavor additive.

### **Examiner’s Response to Affidavit**

Examiner states on page 5 in this Office Action as follows:

The affidavit under 37 CFR 1.132 filed April 29, 2005, is insufficient to overcome the rejection of claims 1-6, 17-25, and 43, based upon the prior art rejections set forth in the last Office action because it is a restatement of Applicant’s arguments which have been addressed above. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

In light of the amendments and arguments presented above, and in addition to the facts presented in the affidavit filed April 29, 2005, Applicants submit that the totality of the evidence shows that Applicants’ invention defined in their Claims would have been non-obvious at the time of their invention.

### **CONCLUSION**

In light of the amendments and the arguments made by Applicants above, as well as the evidence previously submitted by Applicants in the form of the Affidavit of Russell Carl Hosenev, Applicants submit that all existing claims are now in a condition for allowance. Applicants respectfully request that Examiner withdraw all restrictions and rejections with regard to the above-referenced claims in reliance on one or more of the grounds submitted by Applicants.

If there are any outstanding issues that the Examiner feels may be resolved by way of telephone conference, the Examiner is invited to call Colin Cahoon or William Wang at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

The Commissioner is hereby authorized to charge any payments that may be due or credit any overpayments to CARSTENS & CAHOON, LLP Deposit Account 50-0392.

Respectfully submitted by:



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